



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Ch

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/380,835 01/31/00 REY

M ABJ-136

LORUSSO & LOUD
440 COMMERCIAL STREET
BOSTON MA 02109

HM22/0604

EXAMINER

HUANG, E

ART UNIT

PAPER NUMBER

1625

13

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/380,835

Applicant(s)

REY ET AL.

Examiner

Evelyn Huang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1625

1. Claims 1-14 are pending. Claims 15 has been canceled according to the amendment filed on 4-13-2001.

Specification

2. Applicant *has not responded* to the objections to the specification set forth in paragraph 2 of the previous office action.

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

All the chemical structural formulae are missing in the specification. Replacement with new application having the chemical formulae is required.

Claim Rejections - 35 USC § 112

3. The 112 second paragraph rejection is withdrawn for claims 1-6, 8-15 because the amendment has obviated the rejection. The rejection is maintained for claim 7. Deletion of the narrower statements of the limitation and adding dependent claims directed thereto are recommended.

4. The 112 first paragraph rejection is maintained for reasons of record.

Applicant maintains that the claims are fully enabled and argues that applicant needs not supply examples for every possible species in the related chemical reactions.

While every possible species is not required for the claims to be fully enabled, the scope of the claims has to be commensurate with that of the objective enablement. The conclusion that insufficient teaching and guidance are provided in the specification is not based solely on the limited working examples, but is arrived at upon consideration of the evaluation factors as a whole. In view of the high degree of unpredictability in the art, the limited working examples and the breadth of the claims which does not commensurate with that of the objective

Art Unit: 1625

enablement, one of ordinary skill in the art would not be able to use the invention as claimed without undue experimentation.

Claim Rejections - 35 USC § 102

5. The 102 (b) rejections for claim 15 over Piwinski I, II, Wong I, II, the 102(e) rejection for claim 15 over Jackson, Stampa are rendered moot by the cancellation of the claim.

6. The 102(e) rejection for claims 1-13 over Jackson, Stampa is withdrawn because the submission of the official translation of the priority document has established the instant priority date of 3-11-97, which is prior to the US filing date of Jackson or Stampa. These references are no available as prior art under 102(e).

Claim Rejections - 35 USC § 103

7. The 103 rejection for claims 1-15 over Jackson is withdrawn because the submission of the official translation of the priority document has established the instant priority date of 3-11-97, which is prior to the US filing date of Jackson. Jackson is no longer available as prior art under 102(e).

8. The 103 rejection for claims 1-14 over Piwinski II in view of Cid is maintained for reasons of record. Applicant responds to the rejection by cancellation of claim 15. However, cancellation of the compound claim 15 does not render the instant process claims 1-14 unobvious over Piwinski II in view of Cid.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1625

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 703-305-7247. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Venkat can be reached on 703-308-2394. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Evelyn Huang

Primary Examiner

Art Unit 1625

May 28, 2001